

### **REMARKS**

The prosecution history for this case may be generalized as follows. In an Office Action dated October 18, 2002, the Examiner issued a first restriction requirement directed towards then pending claims 1-20. The Examiner stated that restriction to one of the following inventions was required: (I) claims 1-12, drawn to a product, classified in Class 257, subclass 1+; and (II) claims 13-20, drawn to a process, classified in Class 438, subclass 106+. In an Amendment Letter dated December 11, 2002, Applicant elected to prosecute the product Group (I) claims 1-12 to prosecute and added additional claims 21-28 all of which were drawn to a semiconductor stacking structure as shown and described in the patent application as originally filed.

Applicant has filed several Amendment Letters and an RCE in response to Office Actions sent by the Examiner. Each of the Amendment Letters further defined the elected claims of the semiconductor stacking structure. In a first Office Action dated May 11, 2004 after the filing of the RCE, the Examiner rejected Claims 1-12 and 21-28 based on a new reference. In response to the May 11, 2004 Office Action, Applicant submitted an Amendment Letter dated August 6, 2004 amending claims 1, 11,

and 21 to further define the semiconductor stacking structure.

In an Office Action dated October 19, 2004, the Examiner contends that the Amendment Letter dated August 6, 2004 is not fully responsive to the Office Action since amended claims 1, 11, and 21 are drawn to an invention that is independent or distinct from the invention originally claimed. The Examiner withdrew claims 1-12, 21-26 and 29-30 from consideration as being directed to a non-elected invention. An Appeal was filed January 28, 2005 in response to the Examiner's withdrawal of the claims. The Examiner has dismissed the Appeal and now has issued a second restriction requirement directed to Species 1 (Previous Claims, i.e. the claims elected as a result of Applicant's Amendment Letter in response to the first restriction requirement dated October 18, 2002) and Species 2 (New Claims, i.e. the amended claims of the August 6, 2004 reply).

Applicant respectfully traverses this second restriction requirement dated March 2, 2005. Under the PTO rules, a restriction requirement is proper if "two or more independent and distinct inventions are claimed in a single application" 37 CFR 1.142. The Examiner has cited no reason for the restriction requirement other than to set forth the language from the claims

as previously presented in an Amendment Letter dated February 4, 2004 and the language from the claims as presented in the Amendment Letter dated August 6, 2004. The Examiner has not cited any substantive reasons as to why a restriction requirement is necessary. The Examiner further has failed to list any differences in classification for the claims as presented in the Amendment Letter dated February 4, 2004 and the claims as presented in the Amendment Letter dated August 6, 2004.

Applicant further notes that in the restriction requirement dated March 3, 2005, the Examiner states the following:

"In order to clarify the record and clearly state the examiner's position, the restriction requirement of the last office action will be further explained."

Applicant respectfully submits that in the Office Action dated October 19, 2004, no restriction requirement was made by the Examiner. The Examiner did not issue a species restriction requirement in the Office Action, but rather improperly withdrew the claims. Only when Applicant challenged the withdrawal of the claims is when the Examiner issued the species requirement.

Applicant filed an Appeal arguing that the Examiner's withdrawal of pending Claims 1-12 and 21-28 as being directed to a non-elected invention was improperly made and not well

founded. Applicant did not argue in appeal that the first restriction requirement dated October 18, 2002 was improper, but rather that claims amended to further define the elected invention were improperly withdrawn. Applicant respectfully submits that the new restriction requirement in the Office Communication dated March 2, 2005 was made in response to Applicant's argument of improper withdrawal of the claims and not for substantive reasons.

Applicant further objects to the March 2, 2005 restriction requirement under MPEP 707.07(g) which states that the Examiner should avoid piecemeal examination and MPEP 803 which raises the issue of serious burden. Applicant respectfully submits that the Examiner has already issued a first restriction requirement dated October 18, 2002. In the first restriction requirement, the Examiner indicated that the claims are drawn to two separate groups: Group I, Claims 1-12 drawn to a product, and Group II, Claims 13-20 drawn to a process. Applicant respectfully submits that pending Claims 1-12, 21-26 and 29-30 are all product claims that relate to Group I as originally stated by the Examiner in his Office Action dated October 18, 2002 and that the Examiner has not demonstrated any burden to examine those claims as required by MPEP 803. In fact, since the first restriction

requirement dated October 18, 2002 and prior to the second restriction requirement dated March 2, 2005, Applicant has filed an RCE, which entitles Applicant to an examination on the merits.

However, in order to fully respond to the Examiner's restriction requirement, Applicant has elected to prosecute Species 2, Claims 1-12, 21-26 and 29-30 as presented in the Amendment Letter dated August 6, 2004 and as listed above. Applicant requests that the Examiner withdraw the species restriction requirement of March 2, 2005 and examine the application on the merits.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account No. 23-0830.

Respectfully submitted,



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